

**REMARKS**

**I. Formalities**

Applicant thanks the Examiner for considering the references cited with the Information Disclosure Statement filed on August 6, 2003.

However, the Examiner has not yet indicated, in writing, whether the Formal Drawings filed on November 25, 1998 are accepted. Applicant notes that on June 24, 2002, the Examiner stated in response to a telephone inquiry that no corrections to the drawings were required. In addition, the Examiner stated that he would clarify in writing that no objection to the drawings has been made. Accordingly, Applicant respectfully requests that the Examiner formally acknowledge and approve the aforementioned Formal Drawings.

**II. Status of the Application**

By the present Amendment, claims 5, 8, 12, and 14 are amended and claims 15-17 are hereby added to more fully cover various implementations of the invention. Claims 2-17 are all the claims pending in the Application, with claims 5, 7, 8, 10-12, and 14 being in independent form.

The Examiner has indicated that the allowability of claims 2-3, 5-6, 8-9, and 12-14 has been withdrawn in view of the newly discovered U.S. Patent No. 6,011,976 to Michaels et al. (hereinafter "Michaels").

The Examiner has rejected claims 2, 5, 8-9, and 12-14 under 35 U.S.C. § 102(e) as being anticipated by Michaels. The Examiner has also rejected claims 3 and 6 under 35 U.S.C. §

103(a) as being obvious over Michaels in view of U.S. Patent No. 5,764,731 to Yablon (hereinafter "Yablon").

### III. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 4, 7, and 10-11 are allowed.

### IV. Brief Overview of the Present Application and the Cited References

The present Application is directed, *inter alia*, to a process for transmitting a telephone number of a desired subscriber from a directory enquiry facility to a terminal over a telecommunications network with a first channel for voice transmission and a second channel for data transmission, and a directory enquiries facility and a terminal for this process. In particular, independent claims 5, 8, 12, and 14 of the present Application recite that the first channel is configured for parallel use with the second channel.

In contrast to the limitations positively recited in Applicant's claims 5, 8, 12, and 14, Michaels discloses a telecommunications system with a Value Added Service Directory and an integrated circuit module. *See e.g.*, Title. Specifically, Michaels discloses a process for obtaining a telephone number from an operator-assisted directory enquiries system comprising a subscriber initiating a voice call to a network directory enquiries system, and the operator initiating a transfer of the number over Short Message Service ("SMS") into a given memory location of the Subscriber Identity Module ("SIM") of the subscriber's mobile terminal. *See* column 4, lines 17-24. However, Michaels discloses that the operator initiates the SMS process only after the voice call is terminated. *See* column 4, lines 25-28.

In further contrast to Applicant's claims 5, 8, 12, and 14, Yablon discloses a system including a telephone containing a display screen which may show a selected number downloaded from a directory assistance operator. *See* column 11, line 65 – column 12, line 24.

**V. Claim Rejections – 35 U.S.C. § 102**

The Examiner has rejected claims 2, 5, 8-9, and 12-14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,011,976 to Michaels et al. (hereinafter "Michaels"). This rejection is respectfully traversed.

According to the MPEP, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See* MPEP § 2131. Applicant respectfully submits that claims 2, 5, 8-9, and 12-14 positively recite limitations which are not disclosed (or suggested) by Michaels.

**A. Independent Claim 5**

The Examiner alleges that the step of a subscriber obtaining a telephone number by placing a voice call to a network directory enquiries system, as disclosed in Michaels, corresponds to transmitting an enquiry with data describing a desired subscriber from a terminal to a directory enquiry facility on a first channel, as recited in claim 5. In addition, the Examiner alleges that the step of an operator initiating a transfer of the number over SMS into a given memory location of the subscriber's SIM card, as disclosed in Michaels, corresponds to transmitting the telephone number in the form of a numeric string from the directory enquiry facility to the terminal on a second channel, as recited in claim 5. Applicant respectfully

disagrees with the Examiner and submits that Michaels fails to disclose or suggest a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel, as recited in Applicant's claim 5.

To the contrary, Michaels discloses that a subscriber may obtain a telephone number from an operator-assisted directory enquiries system by first initiating a voice call to the network directory enquiries system and thereby giving the operator certain information. *See* column 4, lines 17-21. According to Michaels, once the operator locates the desired number, the subscriber may then choose to receive the located number verbally, or over SMS via a SIM update. *See* column 4, lines 21-25.

However, Michaels also discloses that, if the subscriber chooses to receive the number over SMS via a SIM update, the voice call initiated by the subscriber is terminated and, subsequently, the operator initiates the SMS process. *See* column 4, lines 25-28. Thus, Michaels does not disclose or suggest that the voice call channel and the SMS process (over which the desired number is transmitted) are configured for parallel use, as required by claim 5. In fact, Michaels discloses quite the opposite—that the operator initiates the SMS process only after the voice call is terminated. *See* column 4, lines 25-28. Indeed, Michaels discloses that SMS messages (e.g., the desired number) can be received by a mobile telephone whenever it is idle or on stand-by. *See* column 1, line 20-21. As a result, Michaels does not disclose or suggest a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel, as required by claim 5.

Thus, Applicant respectfully submits that independent claim 5 is patentably distinguishable over Michaels for *at least* these reasons. Further, Applicant respectfully submits that dependent claims 2-3 and 6 are allowable, *at least* by virtue of their dependency on claim 5.

Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

In addition, Applicant submits that dependent claims 15-17 are allowable *at least* by virtue of their dependency on claim 5 and for the recitations set forth therein.

**B. Independent Claim 8**

With respect to claim 8, the Examiner alleges that the network directory enquiries system disclosed in Michaels corresponds to the directory enquiry facility as recited in Applicant's claim 8. Applicant respectfully disagrees with the Examiner and submits that Michaels fails to disclose a directory enquiry facility comprising a receiver means for connecting to a terminal on a line with a first channel for voice transmission, and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel, as recited in Applicant's claim 8.

In contrast, *at least* for reasons analogous to those discussed above with respect to claim 5, Michaels discloses that the operator initiates the SMS process only after the voice call is terminated and that SMS messages (e.g., the desired number) can be received by a mobile telephone whenever it is idle or on stand-by. Consequently, Michaels does not disclose, and is incapable of suggesting, a receiver means for connecting to a terminal on a line with a first

channel for voice transmission, and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel, as recited in Applicant's claim 8.

Thus, Applicant respectfully submits that independent claim 8 is patentably distinguishable over Michaels for *at least* these reasons. Further, Applicant respectfully submits that dependent claim 9 is allowable, *at least* by virtue of its dependency on claim 8.

Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

**C. Independent Claim 12**

With respect to claim 12, the Examiner alleges that the network directory enquiries system disclosed in Michaels corresponds to the directory enquiry facility, as recited in Applicant's claim 12. Applicant respectfully disagrees with the Examiner and submits that Michaels fails to disclose a directory enquiry facility comprising a receiver module configured to receive from a terminal, with a line with a first channel for voice transmission and a second channel for data transmission, an enquiry with data describing a desired subscriber, wherein the first channel is configured for parallel use with the second channel, as recited in Applicant's claim 12.

To the contrary, Michaels discloses that the operator initiates the SMS process only after the voice call is terminated and that SMS messages (e.g., the desired number) can be received by a mobile telephone whenever it is idle or on stand-by. Hence, Michaels does not disclose, and is incapable of suggesting, a receiver module configured to receive from a terminal, with a line with a first channel for voice transmission, and a second channel for data transmission, wherein

the first channel is configured for parallel use with the second channel, as recited in Applicant's claim 12.

Thus, Applicant respectfully submits that independent claim 12 is patentably distinguishable over Michaels for *at least* these reasons. Further, Applicant respectfully submits that dependent claim 13 is allowable, *at least* by virtue of its dependency on claim 12.

Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

**D. Independent Claim 14**

With respect to claim 14, the Examiner alleges that mobile 6 and SIM card 7, as disclosed in Michaels, correspond to a terminal in a telecommunications network comprising a connecting module and a memory, as recited in Applicant's claim 14. Applicant respectfully disagrees with the Examiner and submits that Michaels fails to disclose a connecting module configured to connect to a directory enquiry facility on a line with a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel, as required by claim 14.

In contrast, Michaels discloses that the operator initiates the SMS process only after the voice call is terminated and that SMS messages (e.g., the desired number) can be received by a mobile telephone whenever it is idle or on stand-by. Consequently, Michaels does not disclose, and is incapable of suggesting, a first channel for voice transmission, and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel, as recited in Applicant's claim 14.

Thus, Applicant respectfully submits that independent claim 14 is patentably distinguishable over Michaels for *at least* these reasons.

Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

**VII. Claim Rejections – 35 U.S.C. § 103**

The Examiner has rejected claims 3 and 6 under 35 U.S.C. § 103(a) as being obvious over Michaels in view of U.S. Patent No. 5,764,731 to Yablon (hereinafter “Yablon”). This rejection is respectfully traversed.

In order for the Examiner to maintain a rejection under 35 U.S.C. § 103, Michaels, Yablon, or a combination thereof, must teach all of the limitations of claims 3 and 6. Applicant respectfully submits that neither Michaels, Yablon, nor any combination thereof, teach or suggest all of the limitations of claims 3 and 6.

Claims 3 and 6 incorporate all the novel and non-obvious features of their base claim 5. As explained above with respect to claim 5, Michaels does not disclose a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for parallel use with the second channel. In fact, Michaels teaches quite the opposite—that the operator initiates the SMS process only after the subscriber’s voice call is terminated.

Accordingly, Michaels is incapable of teaching or suggesting the novel limitations of base claim

1. Furthermore, Yablon fails to cure the deficient teachings of Michaels.



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Therefore, claims 3 and 6 would not have been obvious from Michaels, Yablon, or any combination thereof, for *at least* these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

#### VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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